

REMARKS

I. Status of the Claims

Claims 1-45 are pending in the application and stand rejected. Claims 38-45 stand withdrawn pursuant to applicants' election in response the restriction requirement of September 10, 2004, which claims are hereby canceled. Claims 1-37 stand rejected, variously, under 35 U.S.C. §112, second paragraph and 35 U.S.C. §102. Claims 4, 5, 13, and 14 are now canceled, claims 1-3, 6, 15, 16, and 18 are amended, and claim 46 is newly presented. The specific grounds for rejection, and applicants' response thereto, are set out in detail below.

II. Rejection Under 35 U.S.C. §112, Second Paragraph

Claims 1-37 stand rejected under the second paragraph of §112 as lacking a correlation step. Applicants have amended the claim, and the rejection is believed to be overcome.

III. Rejections Under 35 U.S.C. §102

A. U. S. Patent 4,918,162

Claims 1-6, 11, and 13-16 are said to be anticipated by the '162 patent. Claims 4, 5, 13, and 14 are canceled. For the remaining claims, applicants disagree.

The examiner cites the '162 patent for recombinant expression of several N-myc DNA sequences, and finding these proteins using antibodies in immunoprecipitation assays. This has nothing to do with the present invention, which requires (a) obtaining a library of vectors that encode a plurality of distinct candidate polypeptides, wherein said vector provides for the cell surface expression of said candidate polypeptides; (b) expressing each of said plurality of candidate polypeptides on the surface of eukaryotic host cells; and (c) selecting a host cell that expresses a desired polypeptide.

First, the '162 patent does not provide a "library" of vectors or "candidate" polypeptides. Rather, the teachings of the reference merely provide for the recombinant expression of a few specific N-myc proteins. Second, there is no teaching of cell surface expression. In fact, the passage to which the examiner cites *teaches away* from cell surface expression, requiring release of the target either by "shed" of the protein or "lysing" of cells. Col. 7, lines 27-36. Thus, under no construction of the '162 patent can one find an anticipatory disclosure.

Reconsideration and withdrawal of the rejection is therefore respectfully requested.

B. U.S. Patent 5,348,867

Claims 1-6 are rejected as allegedly anticipated by the '867 patent. Claims 4 and 5 are canceled, and for the remaining claims, applicants traverse. As can be seen from the claims presented for reconsideration, the host cells are eukaryotic cells. The '867 only discloses bacterial host cells, and thus cannot anticipate the claims now pending. Reconsideration and withdrawal of the rejection is therefore respectfully requested.

C. U.S. Patent 5,866,344

Claims 1-8 and 11-23 are rejected as anticipated by the '344 patent. Claims 4, 5, 13, and 14 are canceled, and for the remaining claims, applicants traverse, as the present application is a continuation-in-part of the '344 patent. The recombinant expression of antibodies using eukaryotic cells, including yeast, mold, fungi, insect cells and mammalian cells is set forth at column 4, lines 1-21 of the '344 patent (as well as page 6 of the instant specification). Thus, the '344 patent is not prior art against the instant application. Reconsideration and withdrawal of the rejection is therefore respectfully requested.

D. U.S. Patent 6,214,613

Claims 1-10, 13, 14, 16-18 25 and 26 are rejected as anticipated by the '613 patent. Claims 4, 5, 13, and 14 are canceled, and for the remaining claims, applicants traverse. The '613 patent has a §102(e) date of July 12, 1996. The priority date for the instant application, as discussed above, is the same as the parent '344 patent, namely, May 23, 1995. Thus, the '613 patent is not prior art against the instant application. Reconsideration and withdrawal of the rejection is therefore respectfully requested.

IV. Petition for Extension of Time

Pursuant to 37 C.F.R. § 1.136(a), Applicants petition for an extension of time of one month to and including July 10, 2005, in which to respond to the Office Action dated March 10, 2005. Pursuant to 37 C.F.R. § 1.17, a check in the amount of \$55.00 is enclosed, which is the process fee for a one-month extension of time for a small entity.

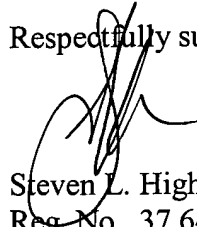
If the check is inadvertently omitted, or should any additional fees under 37 C.F.R. §§ 1.16 to 1.21 be required for any reason relating to the enclosed materials, or should an overpayment be included herein, the Commissioner is authorized to deduct or credit said fees from or to Fulbright & Jaworski Deposit Account No. 50-1212/MXGN:005USC2/SLH.

V. Conclusion

In light of the foregoing, applicants respectfully submit that all claims are in condition for allowance, and an early notice to that effect is earnestly solicited. Should the examiner have any questions, comments, or suggestions relating to this case, the examiner is invited to contact the undersigned Applicants' representative at (512) 536-3184.

Please date stamp and return the enclosed postcard evidencing receipt of this paper.

Respectfully submitted,



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